

## REMARKS

Claims 1-3, 6-11, 16, 17, 19, 21-33, 36-51 and 53-56 were pending.

Claims 2, 6, 7, 32, 33 and 36-49 were previously withdrawn from consideration.

Claim 1 has been amended to recite certain embodiments of the invention more particularly – specifically, to include the recitation of “the posterior layer comprising a plurality of posterior tabs.” Support for the claim amendments can be found throughout the disclosure of the present invention, *e.g.*, in the Specification as filed, page 9, lines 17-21 and Fig. 1(b). Therefore, no new matter has been added.

### I. Rejection of Claims 1, 3, 8-11, 16, 17, 19, 21-31, 50 and 51 Under 35 U.S.C. § 103(a)

Claims 1, 3, 8-11, 16, 17, 19, 21-31, 50 and 51 have been rejected under 35 U.S.C. § 103(a) based on U.S. Patent No. 6,105,329 to Bondoc et al. (“Bondoc”) in view of U.S. Patent No. 6,305,138 to Stahl et al. (“Stahl”) and U.S. Patent No. 6,421,976 to Elliott et al. (“Elliott”). Applicants respectfully traverse these rejections.

First, Bondoc does not teach or suggest each and every limitation of independent claims 1 and 8. In Bondoc (as shown, *e.g.*, in Figure 5), the bottom outermost corners of the shingle (as shown as element “A” in Figure 5 in the Final Office Action) **do not have substantially the same angle as the alignment notch** (which the Final Office Action alleges is element 6 of Bondoc, the “orientation means”). As can be seen from Bondoc Figure 5, the outermost bottom left corner and outermost bottom right corner of the shingles of Bondoc appear generally squared off (that is, more or less at 90° angles), whereas the orientation means (element 6) do not appear to be generally squared off at substantially the same angle. Therefore, at least this element is missing from the teachings of Bondoc.

The Final Office Action alleges that Bondoc does teach this limitation, citing Figure 4 and element 40 (Final Office Action, page 4). However, Applicants respectfully submit that Figure 4 of Bondoc does not teach or suggest the limitation of independent claims 1 and 8 that at least one of the outermost bottom left corner and outermost bottom right corner have **substantially the same angle as the alignment notch**. As noted in the disclosure of Bondoc, Figure 4 depicts an “undivided rectangular posterior layer” and contains no suggestion that such notches have substantially the same angle as an alignment notch. Merely the fact that “it does disclose notches” (Final Office Action, page 4) is insufficient.

Further, the Final Office Action acknowledges that “Bondoc does not disclose the limitations of the shadow band as claimed” (Final Office Action, page 3).

Nor do the teachings of Elliott and Stahl cure the deficiencies of Bondoc. The shingles of Elliott do not cure the defects of Bondoc because, *inter alia*, they do not teach or suggest the limitation that the shadow band is “positioned at an interface between said plurality of posterior tabs and said posterior headlap” as recited in independent claims 1 and 8. In Elliott, the shingles do not comprise a posterior headlap having a plurality of tabs, and therefore, Elliott does not teach a shadow band positioned on the interface between the plurality of posterior tabs and posterior headlap. As can be seen from, *e.g.*, Figures 5 and 6 of Elliott, the shingle taught by Elliott is very different from those recited herein, as, among other differences, it has no posterior tabs. Further, Elliott also does not teach the limitation that at least one of the outermost bottom left corner and outermost bottom right corner have **substantially the same angle as the alignment notch**. Therefore, there is no motivation to combine the teachings of Elliott with those of Bondoc, and such a combination would not result in the presently claimed invention, and would not be successful.

With regard to Stahl, this reference is cited for the proposition that it teaches shadow tips. However, it is clear from the disclosure of Stahl (for example, Figure 2 of Stahl) that Stahl contemplates a shingle wherein the posterior layer (12) is shorter than the anterior layer (11) and is “of substantially half height” thereof (Stahl, col. 3, lines 5-8). In fact, the posterior layer of Stahl is completely different in that it has, *inter alia*, neither a headlap nor a plurality of posterior tabs extending therefrom. Therefore, there would be no motivation to combine the teachings of Stahl with those of Bondoc, and any resultant combination would not yield the presently claimed invention as recited in independent claims 1 and 8.

The Final Office Action alleges that Stahl teaches a shingle having tabs with chamfered corners (Final Office Action, page 4). However, it is important to note that Stahl does not teach both chamfered corners and an alignment notch having substantially the same angle thereof, and there is no motivation to provide a shingle having both, based on the teachings of Stahl and Bondoc. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the results would have been predictable to one of ordinary skill in the art. *KSR International Co. v. Teleflex Inc.*, 82 U.S.P.Q.2d 1385, 1396 (2007). Further, a statement that modifications of the prior art to meet the claimed invention would have been well within the ordinary skill of the art at the time the claimed invention was made because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references. *Ex parte Levengood*, 28 U.S.P.Q.2d 1300 (B.P.A.I. 1993). Here, Stahl teaches that its shingles have the object of providing “sharp, precise delineation between zones of different shadings” (Stahl, Abstract and col. 1, lines 61-63). The shingles of Stahl provide a single shade along their upper portion (15), which object would

be defeated with the presence of an alignment notch having angles – that is, there would be spaces within the shingles created by such an alignment notch, that would mar the “sharp, precise delineation between zones of different shadings.” At least for this reason, there would be no motivation for one of ordinary skill in the art to combine the teachings of Bondoc with those of Stahl in this regard.

Thus, independent claims 1 and 8 are not obvious in view of the combination of these three references, and the same is true of claims 3, 8-11, 17, 17, 19 and 21-31, which depend therefrom.

Independent claim 50 is also not obvious in view of Bondoc, Elliott and Stahl. Bondoc does not teach or suggest each and every limitation of claim 50. The Final Office Action acknowledges that the method recited in claim 50 is not disclosed by Bondoc in view of Stahl and Elliott (Final Office Action, page 11). However, it is alleged that because the shingles of the present invention are obvious in view of Bondoc and Stahl, it would have been obvious to install them in the method recited in claim 50. Applicants respectfully disagree.

First, there is no motivation to combine the teachings of Elliott with those of Bondoc, as discussed above. Elliott is directed to a completely different type of shingle, as it does not teach or suggest a posterior layer having a plurality of posterior tabs extending therefrom, as recited in claim 50. Next, there is also no motivation to combine the teachings of Stahl with those of Bondoc. Stahl does not teach a two-layer shingle, and it does not teach the presence of an alignment notch on the anterior headlap. Moreover, none of the three references teaches or suggests a method of affixing a course of two-layer shingles in such a manner that, *inter alia*, “at least one of said outermost bottom left corner and said outermost bottom right corner of said two-layer composite shingles of said other course aligns to said alignment notch of said two-

layer composite shingles in said previously shingled portion of said roofing area” (claim 50). That is, the presently claimed invention contemplates staggered successive courses of shingles, depending on the alignment of the alignment notch with the outermost bottom left corner or outermost bottom right corner of a different shingle. In contrast, Bondoc, Elliott and Stahl all teach that the shingles are laid down directly, one next to another and one over another, and portions of successive shingles are always in contact in a predictable manner. For example, Stahl states that its shingles have a straight line “L” on their lower edge, as this straight line provides “a number of advantages [including] . . . a guide in applying the shingles in a straight line, one next to the other, and even in applying successive courses, one over the other” (Stahl, col. 2, lines 55-63). Bondoc teaches that the “posterior layer (c) can be continuous, straight strip filling the spaces between the tabs and mounted so that its lower marginal edge is flush with the lowermost tab edges. . .” (Bondoc, col. 3, lines 23-25), suggesting that successive shingles may be laid next to each other both horizontally and vertically. Elliott teaches a predictable pattern for successive courses of shingles, where the overlay members line up with the same portion of the overlay members of successive courses of shingles (Elliott, Figures 3, 4, 7 and 8). Thus, claim 50 does not recite a method of “align[ing] the shingles with the obvious combination of the prior art of record” as alleged in the Final Office Action, page 11.

Thus, independent claim 50 is not obvious in view of Bondoc, Elliott and Stahl, and the same is true of claim 51 which depends therefrom.

For at least these reasons, Applicants respectfully submit that claims 1, 3, 8-11, 16, 17, 19, 21-31, 50 and 51 are patentable over Bondoc, Elliott and Stahl, and therefore respectfully request that the rejection of these claims under 35 U.S.C. § 103(a) has been overcome and should be withdrawn.

## II. Rejection of Claim 53 Under 35 U.S.C. § 103(a)

Claim 53 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over Bondoc in view of U.S. Design Patent No. D375,563 to Hannah (“Hannah”). Applicants respectfully traverse.

First, the Final Office Action acknowledges that Bondoc does not disclose every element of claim 53 – in particular, Bondoc does not disclose, among other things, a plurality of shingles (Final Office Action, page 13). Nor does Hannah cure the defects of Bondoc.

The Office Action alleges essentially that because one shingle claimed in claim 53 would be obvious in view of the teachings of Bondoc, two shingles would also be obvious as merely a “duplication of parts” (Final Office Action, p. 13). However, Applicants respectfully disagree and submit that claim 53 is in fact patentable over the combination of Bondoc and Hannah.

Specifically, Bondoc does not teach or suggest a roofing material comprising multiple roofing shingles having the characteristic, *inter alia*, that the patterns on their anterior layers are substantially repeating. Moreover, there is no motivation to combine the teachings of Hannah with those of Bondoc, as Hannah, being a design patent, is silent as to any features of the shingles other than their aesthetic appearance as depicted in the Figures therein.

Further, to characterize the presently claimed shingle as merely duplicating parts of a single shingle is inaccurate; it has been made clear throughout the file history of the present application, and through past interviews with the Examiner, that to the second shingle of the two-shingle combination as claimed is not in fact, a ***mere duplication*** of the first shingle. A rejection based on the notion that the second shingle is merely “a duplication of parts” of the first shingle ignores the feature of the claim that “the pattern on the anterior layer of one roofing shingle is different than the pattern on the anterior layer of the roofing shingle adjacent to it” (claim 53).

Moreover, there is no teaching or suggestion in Bondoc or Hannah that the pattern of multiple shingles is substantially repeating (claim 53).

For at least these reasons, Applicants respectfully submit that claim 53 is patentable over Bondoc and Hannah, and therefore respectfully request that the rejection of this claim under 35 U.S.C. § 103(a) has been overcome and should be withdrawn.

### III. Rejection of Claims 54-56 Under 35 U.S.C. § 103(a)

Claims 54-56 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Bondoc in view of Stahl and Hannah. Applicants respectfully traverse.

First, Bondoc, Stahl and Hannah do not teach or suggest each and every limitation of claims 54-56, either alone or in combination. Hannah is a design patent that is silent as to any features of the shingles other than their aesthetic appearance as depicted in the Figures therein. In particular, Hannah is silent as to the “substantially repeating” feature present in claims 54-56.

Next, there is no motivation to combine the teachings of Hannah with those of Bondoc and/or Stahl. As stated in Section I, *supra*, there would be no motivation to combine the teachings of Bondoc and Stahl. Among other reasons, Stahl teaches that its shingles have the object of providing “sharp, precise delineation between zones of different shadings” (Stahl, Abstract and col. 1, lines 61-63). The shingles of Stahl provide a single shade along their upper portion (15), which object would be defeated with the presence of an alignment notch having angles – that is, there would be spaces within the shingles created by such an alignment notch, that would mar the “sharp, precise delineation between zones of different shadings.” At least for this reason, there would be no motivation for one of ordinary skill in the art to combine the teachings of Bondoc with those of Stahl in this regard. Nor would there be any motivation to

combine the teachings of Hannah with those of Bondoc and/or Stahl, at least for the reason that Hannah is a design patent that is silent as to any features of the shingles other than their aesthetic appearance as depicted in the Figures therein. In particular, Hannah is silent as to the “substantially repeating” feature present in claims 54-56.

Finally, even if there a motivation to combine the teachings of the three references, there would be no expectation of success in such a combination. In particular, independent claims 54 and 55 both recite the feature “wherein each shingle differs from the shingle adjacent to it based on the position of at least one anterior tab; and wherein the positions of the anterior tabs on the adjacent shingles together form a pattern that is substantially repeating” (claims 54 and 55). These features would not be expected based on these three references. Bondoc and Stahl are both completely silent as to the patterns of adjacent shingles, and Hannah is silent as well – merely providing several different anterior tab designs in a design patent provides no teaching or suggestion that each shingle “differs from the shingle adjacent to it based on the position of at least one anterior tab; and wherein the positions of the anterior tabs on the adjacent shingles together form a pattern that is substantially repeating.” As claim 56 depends from claim 55 and therefore incorporates all of its limitations, this claim is also not obvious in view of these references.

For at least these reasons, Applicants respectfully submit that claims 54-56 are patentable over Bondoc, Stahl and Hannah, and therefore respectfully request that the rejection of these claims under 35 U.S.C. § 103(a) has been overcome and should be withdrawn.



#### IV. Conclusion

In view of the above amendments and remarks, Applicants respectfully submit that the claims are now in condition for allowance, early notice of which is earnestly solicited. Should any outstanding issues remain, the Examiner is hereby invited to contact Applicants' undersigned attorneys at the telephone number below.

The Director is hereby authorized to charge any necessary fees associated with this filing, or credit any overpayment, to Deposit Account No. 03-1250, Reference No. 12080001.000019, Customer No. 43,309.

Respectfully submitted,

Date: February 23, 2010

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